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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/384,182 08/27/99 KAY

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EXAMINER

PM82/0301

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FISCHER, A

ART UNIT

PAPER NUMBER

2167

DATE MAILED:

03/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/384,182

Applicant(s)

Kay et al

Examiner

Andrew J. Fischer

Group Art Unit

2167



☒ Responsive to communication(s) filed on Nov 15, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 29-60 is/are pending in the application.

Of the above, claim(s) 48-60 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 29-47 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 5, 7, 8

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 29-47, drawn to an electronic commerce system architecture, classified in class 705, subclass 28.
  - II. Claims 48-60, drawn to a method of facilitating electronic commerce, classified in class 705, subclass 28.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process may be practiced by a materially different apparatus (e.g. one that does not require a first plurality of network servers in conjunction with second and central servers).
3. Because these inventions are distinct for the reasons given above, because the search required for Group I is not required for Group II, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Alfred A. Stadnicki prior to February 6, 2001, a provisional election was made with traverse to prosecute the invention of the system, claims 29-

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47. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 48-60 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

#### ***Information Disclosure Statement***

6. The information disclosure statement filed September 27, 1999 (Paper No 4) fails in part to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it omits the place of publication and publication date (month and year); see "Other Documents" page 2. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

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***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. It is unclear if the “second product related data” (as recited in line 8) is the same or different from the “second product related data” as recited in claim 29.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 29-36, 41- are rejected under 35 U.S.C. 102(b) as being anticipated by PowerTV Inc, White Paper titled ‘Applications and Service Infrastructure’ (“PowerTV”). PowerTV discloses a system with the following: a first plurality of servers (page 18, HTTP Proxy Server, the Local HTTP Server, and the email server) each configured to communicate with a first plurality of network devices (the set-top boxes) associated with a first network (the network connecting the first plurality of servers with the set top boxes), the first servers receive a first

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product related request from one of the first one of the first plurality of network devices (the user orders products or gets info via email and the world wide web ("WWW")); a second server (a service provider webserver such as compuserve, AOL, earthlink, or mindspring or content sever such as tucows.com) having a first database storing first product related data (to be transmitted, it is stored at least temporarily), to transmit the stored first product related data to the servers (either via email or the WWW in HTML); a central server (at a e-commerce website) storing first and second product related data (price, quantity, and garment size) configured to transmit first and second product related data, to receive the first product related request and to store the received request (the e-commerce sites store the sale information for accounting purposes); the first and second product related data stored in the first database are the second product related data transmitted by the second server (i.e., the second server transmits the data from the central server, a common internet function); the first plurality of servers is configured to transmit applications (java executing on the set top boxes or the PowerTV Web Browsers, page 23) operable to receive the product related data (java or web browser data); wherein the first product related data is a request to purchase a product (e.g. purchase a sweater or information via compuserve); the first network is a video broadcast network (figure 2, page 18); the first product related data is different from the second product related data (inherent); the first product related data stored in the first and second databases correspond to a preference of a user associated with a network device (the server stores the user's information accessible with a password); the first product related request (e.g. a request for a particular broadcast video) is transmittable to one of the

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network devices only if the one network device is tuned to one of the multiple broadcast channels (the operator is allowed to choose the content of programing, page 3); the first product related data transmitted to the one network device is viewable in conjunction with video programming broadcast over one channel (broadcast and two way communications with, for example, on-demand video, page 12);

11. Functional recitation(s) using the word “to” (e.g. “to receive first product related data” as recited in claim 29) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Examiner recommends removing “to” where the intended use is not desired.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claim 37 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PowerTV. It is the Examiner position that the second plurality of first servers and a third server are either directly or inherently disclosed since the network is connected to the Internet and Internet applications may contain many servers.

However, if not directly or inherently disclosed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV to include the duplicate servers. Such a modification is a mere duplication of parts. See MPEP §2144.04 VI. B.

14. Claims 38-40 rejected under 35 U.S.C. 103(a) as being unpatentable over PowerTV in view of Condon (U.S. 5,956,714). PowerTV discloses as discussed above and does not directly disclose using priority queues. Condon teaches using priority based queues in a plurality of servers to increase efficiency in a database.


Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify PowerTV as taught by Condon to include the following high and low priority queues. Such a modification would have reduced the processing time for high priority queries in the database.

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***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Adiga et. al. (U.S. 5,946,466); Wasilewski et. al. (U.S. 6,157,719); Siefert (U.S. 5,699,526); Chelliah et. al. (U.S. 5,710,887); Fuller et. al. (U.S. 5,767,894); Fox et. al. (U.S. 5,790,677); Tanaka et. al. (U.S. 5,610,841); Chapman et. al. (U.S. 5,977,962); MacInnis (U.S. 5,951,639); and Houha et. al. (U.S. 5,734,822).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

  
ANDREW J. FISCHER  
PATENT EXAMINER

AJF  
February 26, 2001

 2/26/01  
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